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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 10030552-1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number 10/684,281	Filed 10/10/2003
on ___September 11, 2008___	First Named Inventor Reid F. Hayhow	
Signature /Gregory W. Osterloth/		
Typed or printed name Gregory W. Osterloth	Art Unit 3685	Examiner Worjloh, Jalatee

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. 36,232
Registration number _____.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Gregory W. Osterloth/
_____
Signature

Gregory W. Osterloth
_____
Typed or printed name

(303) 295-8205
_____
Telephone number

September 11, 2008
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

SEP 17 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/684,281	Confirmation No. 3341
Applicant	:	Reid F. Hayhow	
Filed	:	October 10, 2003	
TC/A.U.	:	3621	
Examiner	:	Jalatee Worjloh	

Docket No.   :   10030552-1

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

In response to the Final Office Action of April 21, 2008 and the Advisory Action of August 11, 2008, applicant has filed a "Notice of Appeal" and "Pre-Appeal Brief Request for Review" with this "Pre-Appeal Brief".

Claims 14-25 stand rejected under 35 USC 102(e) as being anticipated by Organ et al. (US Pat. No. 7,191,368; hereinafter "Organ").

Applicant's claim 14 recites:

14.   A system comprising:
     a tester to apply one or more tests to a device; and
     logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license and to create at least one log file having resource use information for one or more tests executed on the tester.

With respect to claim 14, the Examiner asserts that:

. . .Organ discloses a tester to apply to one or more testes [sic] to a device (see abstract - an electronic tester; a test head is coupled to a device under test), logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license (i.e. rule)

(see col. 12, lines 4-6) and to create at least one log file having resources use information for one or more tests executed on the tester (see col. 14, lines 46-50).

4/21/2008 Final Office Action, p. 3.

Applicant respectfully disagrees. Organ's col. 12, lines 4-6, recites:

> When a program is loaded, the information is resolved into specific attributes of the selected tester. Tester resource allocation and *rules* checking is performed at this time.

(Emphasis added)

The above is Organ's only mention of "rules". Applicant asserts that nothing in the above excerpt mentions or implies that "rules checking" includes license checking. Nor does the above excerpt mention or imply that Organ utilizes an "electronic license" to enable one or more resources of a tester. Further, it is noted that Organ's disclosure does not mention a "license" or "licensing" even once. As a result, applicant asserts that Organ is devoid of any teaching or suggestion of "logic. . .to enable one or more resources of [a] tester according to one or more properties of an electronic license". Claim 14 is believed to be allowable for at least this reason.

The argument set forth above was first made in applicant's Amendment dated January 21, 2008. In the Examiner's 4/21/2008 Final Office Action, the Examiner responded to applicant's argument by asserting that the phrase "to enable one or more resources of [a] tester according to one or more properties of an electronic license" was merely a recitation of a new intended use for an old product (i.e., a new intended use for Organ's apparatus). Applicant respectfully disagrees.

The Examiner cites *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997) for the proposition that "the recitation of a new intended use of an old product does not make a claim to that old product patentable." However, the claims at issue in *Schreiber* were directed to a simple mechanical device - i.e., a generally conical shaped device for dispensing popcorn. In *Schreiber*, the court found that Schreiber's claim to a generally conical shaped device for dispensing popcorn was anticipated by a generally conical shaped device for dispensing oil. The court also found that the

conical shaped device for dispensing oil would inherently be able to perform Schreiber's function of "dispensing popcorn".

In contrast to the simple mechanical device that was at issue in *Schreiber*, applicant's claim 14 recites a system comprising "a tester" and "logic, communicatively coupled to the tester". Applicant's claim 14 also recites some functions that are performed by the logic. Nowhere does Organ teach or suggest that such functions are performed (inherently or otherwise) by any element of Organ's apparatus. At a minimum, the performance of the functions recited by applicant's claim 14 would require a reprogramming or reconfiguration of Organ's apparatus so that it could perform the new functions of applicant's claim 14. In other words, Organ's apparatus is not inherently capable of performing the functions of applicant's claimed "logic".

Furthermore, the logic of applicant's claim 14 is indicated to be "communicatively coupled to the tester, ***to enable one or more resources of the tester***". Even if one takes the position that applicant's claim 14 merely recites a new intended use for Organ's computer, and that a computer which undertakes "rules checking" could inherently perform "license checking", the fact remains that Organ does not disclose "logic. . .to enable one or more resources of the tester". That is, Organ does not indicate that "rules checking" is used to enable resources of a tester. Rather, Organ only discloses the use of "rules checking" for "tester resource allocation", the resolving of timing information, and the loading of programs. *See*, col. 12, lines 4-9. Applicant asserts that the "allocation" of tester resources is not equivalent to the "enablement" of tester resources, and "allocation" (i.e., deciding how enabled resources are used) does not suggest "enablement" (i.e., deciding whether resources are enabled at all). Thus, Organ not only fails to disclose license checking, but Organ also fails to disclose any structural or functional relationship between a "tester" and "logic" that allows the logic "to enable one or more resources of the tester."

The Examiner also rejects claim 14 on the basis that Organ, in col. 14, lines 46-50, discloses "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester". Organ's col. 14, lines 46-50, recites:

. . .Button number 228 of operator tool 160 allows the user to turn on or turn off the enVision++ data log. When the envision data log is turned on, the measurements made during digital testing of DUT 50 are written to a file. Area 239 of operator tool 160 is used to display status.

Applicant asserts that nothing in the above excerpt teaches the creation of a log file having "resource use information". That is, the enVision++ *data log* is only a "data log", or a log of "measurements made during digital testing". Organ does not indicate or suggest that the enVision++ log should additionally or alternately be used to log *"resource use information"*, as recited in applicant's claim 14. Claim 14 is therefore believed to be allowable for this additional reason.

Of note, the Examiner has not responded to applicant's above argument concerning the failure of Organ to disclose "logic. . .to create at least one log file having resource use information for one or more tests executed on [a] tester".

For the reasons given above, applicant believes the Examiner has failed to state a prima facie basis for rejecting claim 14.

Claims 15-25 are believed to be allowable, at least, because they depend from claim 14.

Respectfully submitted,
HOLLAND & HART, LLP

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